

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-3 remain pending. Claim 2 has been amended to recite “an other region” and clarify with respect to the first recited region. Claims 8-14 have been added to secure an appropriate scope of protection to which applicant is believed entitled.

Yasui (Japanese Patent JP-04363163A) fails to anticipate the subject matter of the present invention as claimed in claim 1 as Yasui fails to include the steps of: (1) providing a paste applying machine for discharging a molten paste of thermoplastic material and (2) spreading the molten paste by means of centrifugal force acting on the cylinder being rotated.

A rejection based on 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. The Examiner has failed to identify all elements of claim 1 as anticipated by Yasui.

At the outset, applicant would like to point out that a complete translation of the Yasui reference has not been obtained and English-language equivalents are not apparently available. The entirety of the Examiner’s arguments and assertions are based solely on the Figures and the brief English-language abstract. The Examiner is requested to provide an English-language translation of the reference, or an English-language equivalent of the reference, if the reference is further relied on by the Examiner.

First, Yasui fails to describe providing a paste applying machine for discharging a molten paste of thermoplastic material. As recited in the Abstract, Yasui describes a synthetic resin primer applied on the inside or outside surface of the pipe body and “a thermoplastic resin powder is thermally sprayed . . . on the inside or outside surface of the pipe body.” Yasui fails to describe discharge of a molten paste of thermoplastic material. In contrast, Yasui recites thermal spraying of a thermoplastic powder and application of a synthetic resin primer. There is no support in the Abstract or Figures of Yasui for forming a coated film of a molten paste of a thermoplastic material.

Second, Yasui fails to describe spreading a molten paste by means of centrifugal force acting on the cylinder being rotated. Without an English-language translation of Yasui, Applicant would be required to improperly speculate as to the component parts and operation

thereof of the Yasui coating device as neither the Figures nor the Abstract describe or depict rotation of the pipe body. There is no mention of pipe body rotation in the Yasui Abstract.

Additionally, the Examiner asserts that rotation of the cylinder (though not shown in Yasui) inherently creates a rotational force which “creates spreading and thereby wholly covers the region with molten paste.” Instant Office Action at page 4, lines 1-2. The Examiner is reminded of the standard for inherency which has not been met in this case.

In order to rely upon a theory of inherency, the Examiner is required to provide a factual basis and/or technical reasoning reasonably supporting the determination that the allegedly inherent characteristic **necessarily** flows from the prior art teaching. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). “The mere fact that a certain thing **may** result from a given set of circumstances **is not sufficient.**” In re Robertson, 169 F.3d 743, 745, 49 USPQ3d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). “A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” Rosco v. Mirror Lite, 304 F.3d 1373, 1380 (Fed. Cir. 2002). The Examiner has failed to support the inherency assertion regarding the centrifugal force acting on the cylinder being rotated.

For any of the foregoing reasons, claim 1 is patentably distinguishable from Yasui.

Yasui fails to anticipate the subject matter of the present invention as claimed in claim 2 for at least the reasons advanced above with respect to claim 1. Further, the Examiner asserts that Yasui inherently discloses that the viscosity of the thermally treated molten paste, the speed of the cylinder, and speed of movement of the nozzle have been determined so as to prevent the molten paste from being scattered to a region other than said region; however, as stated above, without an English-language translation of Yasui there is no support in the Figures or Abstract for the Examiner’s assertions.

Bearing in mind the above-provided standard for inherency, the Examiner has failed to meet the burden of proof with respect to the claim 2 limitations. That is, the Examiner has failed to identify a factual basis or provide a technical reasoning reasonably supporting the determination that the allegedly inherent characteristics **necessarily** flow from the prior art teaching. It is unclear how the Examiner can assert that viscosity of the molten paste, rotational speed of the cylinder, and the speed of nozzle movement are determined when none of these factors are even mentioned in the Abstract nor depicted in the Figures. For at least this reason, in

addition to those reasons recited above, claim 2 is patentably distinguishable from Yasui.

Yasui fails to render obvious the subject matter of the present invention as claimed in claim 3 for at least the reasons advanced above with respect to claims 1 and 2. With respect to claim 3, the Examiner asserts that the recited values and ranges would be discoverable by routine experimentation; however, a “particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the present case, Yasui (based on the Abstract and Figures only) fails to recognize the result and doesn’t even begin to recognize the variables as achieving the result. That is, Yasui fails to recognize at least the use of centrifugal force to spread the molten paste.

Additionally, because Yasui describes the use of an adhesive resin primer (“synthetic resin primer having adhesiveness”) prior to application of the thermoplastic resin powder, Yasui teaches away from any use of centrifugal force to spread molten paste as the adhesive would tend to restrict spreading of an applied paste. Based on Yasui’s use of an adhesive in this manner, it appears that Yasui is directed at preventing the spread of molten paste. In contrast, the claimed subject matter of claim 3 spreads the molten paste.


For any of the foregoing reasons, claim 3 is patentable over Yasui.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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